II. REMARKS

In the Office Action dated May 2, 2008, claims 23, and 35-39 were pending. Claims 23 and 35-39 were rejected.

The rejected claims have been amended and support for the allowability of the amended claims is included herein. The Examiner's careful consideration of the amended claims is respectfully requested.

The following remarks will follow the order set forth in the Office Action.

A. DOUBLE PATENTING REJECTION

Claims 23 and 35-39 have been rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,862,571. Applicant is willing to file a terminal disclaimer if the prior art rejections are overcome.

B. REJECTION UNDER SECTION 102

Claims 23 and 35-39 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,862,571 to Martin et al. Since the present application is a continuation of U.S. Patent No. 6,862,571, and the priority is acknowledged, the applicant believes the 102(e) rejection is improper. As noted in MPEP §201.11 and 35 U.S.C. §120, "An application for patent for an invention disclosed...which is filed by an inventor...named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application...." Therefore, the 102(e) rejection should be removed.

C. REJECTIONS UNDER 35 U.S.C. §103

Claims 23 and 35-39 were rejected under 35 USC §103 as being obvious over US Pat. No. 6,035,276 to Newman et al ("Newman"). The propriety of the rejection of each claim will be addressed individually.

The Newman patent deals strictly with the use of information on a credentialing application, and transference of information from a credentialing application to another credentialing application. Newman states, "Preferably, the credentialing information related to a particular physician desiring to use the present invention is initially input in a common universal format, referred to as a universal application form...." (col. 3, lines 17-20). The reference 36 in Newman is not an insurance application.

The Examiner is modifying the reference without any support for doing so. Firstly, a credentialing application is *not* an insurance application. Secondly, the insurance industry is clearly divided into two separate categories - life and health and property and casualty. Medical malpractice insurance is property and casualty insurance, while, if credentialing were associated with a particular type of insurance, it would be life and health. Insurance agents are licensed to sell different types of insurance, and it is not uncommon for an agent to be licensed to sell life and health, but not property and casualty. Therefore, even within the insurance field, there is a clear distinction. As such, the Newman reference would have to be improperly modified in order to obtain the statement made by the Office Action ("[Newman] does not specifically disclose

malpractice insurance policy. However, it would have been obvious to one skilled in the art at the time of the invention to modify the 'the provider application database' of [Newman] to show the malpractice insurance policy because it is an obvious component of 'the provider application database.'"

35 USC §103 requires that the subject matter as a whole be reviewed. There are certain limitations of Claims 23, and 35-39, which are still not shown in Newman. For example, Newman does not suggest or disclose the transference of information from a medical malpractice insurance application to a credentialing application. Also, Newman does not disclose "providing at least one blank space on the questionnaire where information from the insurance policy does not match with at least one question on the questionnaire and requesting information from the healthcare provider to fill in the at least one blank space" as recited in claim 35. The Examiner states that Newman teaches this with the database field 56, database 58, and blank 60, but Newman makes no reference to matching information from a medical malpractice insurance application to a credentialing application, then leaving a space for the physician to fill in any missing information. The blank 60 of Newman is just matching database fields, not information from a medical malpractice insurance application. There is also no reference in Newman to the physician filling in any missing information. According to 35 USC §103, it must be considered and given proper weight if the correct result is to be reached.

Newman does not refer to the need for automatically transferring information from a medical malpractice insurance application to a credentialing application. Also, Newman does

not teach the problem of insufficient information on insurance applications, as well the length of time required in filling out both the credentialing application and a medical insurance application. The current invention limits the time spent by the doctor to filling out a single application, whereas Newman still requires the physician to fill out two separate applications in order to have both a credentialing application and a medical malpractice insurance application. The prior art clearly does not teach the source of the problem and therefore could not be said to teach its solution.

III. CONCLUSION

In response to the Office Action dated May 2, 2008, applicant believes that the claims remaining in the case distinguish over the art cited and comply with the requirements of 35 U.S.C. §102, §103, and §112. As such, allowance of the claims is respectfully requested.

The Commissioner is hereby authorized to charge any deficiency in the required fee or to credit any overpayment to Deposit Account No. 50-4538.

Respectfully submitted,

EMERSON, THOMSON & BENNETT

October 2, 2008
Date

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